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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/144,900	09/01/1998	NEIL L. MCCLURE	404161	5328
24283	7590	11/03/2005	EXAMINER	
PATTON BOGGS 1660 LINCOLN ST SUITE 2050 DENVER, CO 80264			FRIDIE JR, WILLMON	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/144,900	MCCLURE ET AL.	
	Examiner	Art Unit	
	Willmon Fridie	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('325).

Kahle discloses a method and system for individually labeling a compact disk at the time digital information is recorded. However Kahle lacks the disclosure of a base plate in cooperation with a pestle to apply the label to the compact disk. It would have been obvious to a skilled artisan at the time the invention was made to use a base plate and pestle arrangement, since applicant has not disclosed that the use of this combination solves any stated problem or is for any particular purpose. Webster's dictionary defines pestle as "any of various devices for pounding, stamping or pressing". Hence the

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examiner submits that it appears the invention would perform equally well with any known equivalent elements.

With respect to claims 7-9 Kahle states:

"...at least a portion of the digital information that is stored in a storage location is transferred in the form of a first digital data stream to the medium. A visual label having title information produced from a second data stream (produced independently of the first data stream) is placed on the recording medium."

Kahle further states:

"To extract the portion of the digital data stream having the title information, the controller 28 uses software available from vendors such as Bell & Howell, Chicago, Ill. This software uses parameter tables to parse the data stream, extract data fields, and compose the title information. In this manner, the printer 30 can produce the visual label on the CD-R 10 without human intervention. "

In regard to claims 7- 9, the examiner submits that Kahle inherently produces a list, storing data files, associating said files and using a statistical comparative analysis to identify the disk.

With respect to claim 10, Kahle states:

"The digital information stored on the disk will typically be unique from the information stored on any other disk. For example, if a company's customer records were alphabetically stored on a set of disks, one of the disks may have the records of customers whose names begin with the letters A-M, while another disk contains the records of customers having names beginning with the letters N-Z. Other examples are almost limitless. That is not to say that no two disks will ever contain the same information, but that a primary objective of this invention is the bulk storage of data for archival and other purposes. This differs from CD-ROMs which typically have the same digital information replicated in mass."

Kahle further states:

"Digital information is recorded on the CD-R by a compact disk recorder. Digital information includes any kind of information that can be communicated to a person by sight or sound that has been put in the form of digital quanta, typically in binary form. This is commonly referred to as "digitizing" information. For example, textual information, analog sound signals, and other forms of information can be digitized by conventional techniques, e.g. converting an analog signal to a digital signal in an analog-to-digital converter, inputting textual information using keyboards, scanners, and the like."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an electronic identifier on the disk since it would only depend on the intended use of the assembly and the desired information to be conveyed.

Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information media does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

With respect to claim 12, Kahle states:

"...an attachable label 20 which has been separately printed can be attached to the labelling portion 16. As will be described in detail hereinafter, the attachable label 20 can be separately printed by any conventional printer or labeller. Preferably, the attachable label 20 will have a self-adhesive on one side to allow the label 20 to easily be attached to the labelling portion 16 of the CD-R 10. The attachable label 20 will contain identical title information as just discussed in connection with FIG. 1."

Hence, Kahle inherently discloses a destructible label because it is well known in the art that any label applied by adhesive can be removed, destroyed or defaced.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willmon Fridie whose telephone number is 571 272 4476. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571 272 4502. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**WILLMON FRIDIE, JR.
PRIMARY EXAMINER**